

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gerardo KOBEH et al.

Serial No.: 10/673,431

Filed: September 30, 2003

For: GRANTS MANAGEMENT SYSTEM

Examiner: Michael R. Zecher

Art Unit: 3691

Confirmation No.: 2620

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mailstop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request a review of the final rejection in the above-captioned application. No amendments are being filed with this Request.

This Request is being filed concurrently with a Notice of Appeal.

The review is requested for the reasons stated in the following remarks beginning on page 2.

REMARKS

Claims 1-27 are pending in this application. Claims 1-27 have been rejected in the final office action. In view of following remarks, the Applicants respectfully request allowance of claims 1-27.

KANEFSKY IS NOT A PROPER PRIOR REFERENCE

Claims 1-10, 13-18, 20 and 22-27 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0072999 ("Corrie"), in view of U.S. Patent Application Publication No. 2005/0192826 ("Kanefsky"). Claims 11, 19 and 21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie and Kanefsky in view of Official Notice. Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie and Kanefsky, and in further view of U.S. Patent No. 7,111,010 to Chen et al. ("Chen").

The outstanding rejections are fatally defective because they rely on a reference – Kanefsky – that is not prior art. Kanefsky is a published application that was filed after the present application. The Final Office Action relies on the filing date of a provisional application, which was filed before the filing date of the present application. Kanefsky's provisional application, however, has different disclosure than Kanefsky's published application. To reject the pending claims, the ***Final Office Action relies on disclosure that does not appear in Kanefsky's provisional application.*** The Office cannot rely on the filing date of the provisional application if the allegedly invalidating disclosure of Kanefsky's published application is not found in his provisional application. See, M.P.E.P. 2136.02 (III) (reliance on provisional application permitted only if provisional has the same disclosure as published application).

| DOCUMENT | FILING DATE |
|------------------------------------|--------------------|
| Kanefsky's Provisional Application | August 21, 2003 |
| The Pending Application | September 30, 2003 |
| Kanefsky's Published Application | August 20, 2004 |

Table 1

Kanefsky's Provisional Application does not disclose the same subject matter of Kanefsky's Published Application. The subject matter on which the Examiner relied in rejecting

claims of the present application do not appear in Kanefsky's Published Application. In the Final Office Action, the Examiner relied on Fig. 1 and ¶ 21 of Kanefsky's Published Application to reject independent claims 1, 6, 10, 13, 23, and 27.¹ Kanefsky's Provisional Application ***does not provide this disclosure***. The Examiner also relied on FIG. 4 and ¶ 33 of Kanefsky's Published Application to reject claims 1, 6, 10, 26, and 27. Kanefsky's Provisional Application ***does not provide this disclosure***, either. The Final Office Action has rejected the pending claims on disclosure is not present in Kanefsky's Provisional Application. Therefore, the rejections are based on legal erroneous.

Applicants identified these errors in their After Final Response but they were ignored in subsequent analysis. Given that the Office bears the initial burden of factually supporting any *prima facie* conclusion of obviousness (M.P.E.P. 2142), the Examiner must identify where in Kanefsky's Provisional Application the subject matter of the rejected claims is disclosed.

All independent claims 1, 6, 10, 13, 23, 26, and 27, and their respective dependent claims 2-5, 7-9, 11, 12, 14-22, 24, and 25 are allowable.

THE REJECTION DOES NOT CONSIDER ALL ELEMENTS OF CLAIMS 1-5

The Final Office Action fails to address all elements of the pending claims when rejecting claims 1-5 for obviousness. Independent claim 1, for example, recites:

responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants.

The Final Office Action ignored this feature in the final rejection. Applicants identified this oversight in the after final response but the Office ignored this feature again in the advisory action. The Office has failed to demonstrate that the cited art meets all elements of the pending claims and, therefore, the Examiner failed to make a *prima facie* case of obviousness. See M.P.E.P. 2143.03 (All claim limitations must be considered). The obviousness rejection to claim 1 and its dependent claims 2-5 must be reversed on these grounds as well.

¹See, Final Office Action, page 3, line 18

CONCLUSION

All outstanding rejections have been overcome. It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Respectfully submitted,

Date: October 31, 2008

/Robert L. Hails/

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

11884/406501

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on _____

Signature _____

Typed or printed name _____

Application Number

10/673,431

Filed

09-30-2003

First Named Inventor

Gerardo Kobeh

Art Unit

3691

Examiner

ZECHER, MICHAEL R

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Robert L. Hails/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Robert L. Hails

Typed or printed name

☒ attorney or agent of record.

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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

October 31, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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